



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,513	05/05/2001	Dennis G. Earnshaw	070325-040017	8685
33717 7590 11/26/2007 GREENBERG TRAUIG LLP (LA) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404			EXAMINER VIG, NARESH	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/849,513	<b>Applicant(s)</b> EARNSHAW, DENNIS G.	
	<b>Examiner</b> Naresh Vig	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 14-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-20, 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3629

### **DETAILED ACTION**

This is in reference to communication received on 25 September 2007. Claims 1 – 10, 14 – 20 and 22 – 24 are pending for examination.

#### ***Response to Arguments***

Applicant's arguments and concerns are for amended claims which have been responded to in response to pending claims.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 10 and 14 – 18 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant recites the limitation "determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that determines the preferred communication format of each of the plurality of recipient

Art Unit: 3629

parties of the business transaction". However, as currently claimed as their invention, it is not clear how the transaction service server will determine the preferred communication format for each of the plurality recipient because claimed invention does not have capability of determination of preferred communication format for recipient party. For example, is the party registered with the transaction service server, or, transaction service server has pre-determined communication format stored on its database etc.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, 7 – 10, 14, 18 – 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over an IBM Corporation product Facsimile Support/400 hereinafter known as IBM in view of Henry US Patent 6,424,426 and Akimoto US Patent 6,775,711.**

Art Unit: 3629

**Regarding claims 1, 14 and 19**, as best understood by examiner, IBM teaches idea of a business transaction document which can be directed to plurality of parties [IBM, page 106], wherein the business document can be sent to a recipient party in their preferred communication format. IBM teaches capability for:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program. IBM teaches the electronic business transaction document being directed a communication formats to plural recipient parties to a business transaction [IBM, page 106], the electronic business transaction document being created by a business management software program in the client computer the electronic business transaction document including address information. IBM does not explicitly teach preferred communication format indicator for each of the plurality of recipient parties of the business transaction.

However, Henry teaches idea wherein a business document can be sent be a server to a recipient party in their preferred format (fax-to-email and email-to-fax formats). This clearly teach the idea that IBM Facsimile Server can be modified to send document as taught by Henry [Henry, Fig. 6 and disclosure associated with the Figure].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM as taught by Henry to enable a user device to send emails from any facsimile capable device and also able to send facsimiles to any other facsimile device, from either a centralized web server or a client machine.

IBM teaches using address book [Master List, Distribution List, IBM, page 106] IBM in view of Henry teaches capability for retrieving address information and the

Art Unit: 3629

preferred communication format from an electronic address book stored at the client computer [Distribution list, master list, IBM, page 106], wherein the electronic business transaction document is received by a transaction service server computer communicated with the client computer through a computer network;

IBM in view of Henry does not explicitly teach determining at the transaction services service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. However, Akimoto teaches determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction, wherein the electronic business transaction document is received by a transaction service server computer communicated with the client computer through a computer network [IBM, page 1, 2, 4; Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry as taught by Akimoto to make it possible to add a plurality of new functions with minimal changes to the existing system.

Art Unit: 3629

IBM in view of Henry and Akimoto teaches capability wherein:

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a computer communication format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8]; and

if the transaction service computer determines that the preferred business transaction document communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

**Regarding claims 2 and 20**, IBM in view of Henry and Akimoto teaches capability wherein preferred communication format includes telephonic facsimile.

**Regarding claim 7**, as responded to earlier, IBM in view of Henry and Akimoto teaches capability wherein business management software program is capable of automatically extracting and populating information from the electronic business transaction document, transmitting access to the business management software component with the electronic business transaction document in the computer format to the at least one recipient party, if it is determined that the at least one recipient party is not capable of viewing the electronic business transaction document, the business

Art Unit: 3629

management software component not being capable of automatically populating and extracting information from electronic business transaction documents (obvious to one of ordinary skill in the art at the time the invention was made that if a user does not have capability for handling electronic file, they will not be able to view the electronic file, for example, a user with computer environment which does not have graphic capability will not be able to recreate graphics to be displayed on their computer).

**Regarding claims 8 – 9**, IBM in view of Henry and Akimoto teaches capability wherein the electronic business transaction document can include a markup language or Extensible Markup Language as content in the computer file.

**Regarding claims 10 and 18**, as responded to earlier, IBM in view of Henry and Akimoto teaches capability wherein business transaction can be related to a construction project.

**Regarding claim 23**, IBM in view of Henry and Akimoto teaches capability for manually changing the preferred communication format automatically associated with the recipient party prior to sending the electronic business transaction document to a recipient party [Akimoto, Fig. 8 and disclosure associated with Fig. 8].



Art Unit: 3629

**Claims 3 - 6, 15 – 17, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over an IBM Corporation product Facsimile Support/400 hereinafter known as IBM in view of Henry US Patent 6,424,426, Akimoto US Patent 6,775,711 and NetGram.com hereinafter known as NetGram.**

**Regarding claim 3,** IBM in view of Henry and Akimoto does not explicitly teach the preferred communication format includes regular mail, a printed copy of the electronic business transaction document is mailed to a recipient party. However, Henry in view of Akimoto teaches plurality of tags can be used to indicate different type of delivery means for a recipient [Akimoto, Fig. 7, 8 and disclosure associated with fig. 7, 8]. Also, it is known at the time of invention to one of ordinary skill in the art that businesses have mailed printed copy of business transaction document to recipient party. However, NetGram teaches services for sending sender's electronic document via postal mail to recipient of the document [NetGram page 11 – 13].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry and Akimoto as taught by NetGram to allow senders outsource mailing of their business documents.

**Regarding claims 4 and 15,** IBM in view of Henry and Akimoto does not explicitly teach storing in an electronic address book address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction indicating the one of the computer and non-computer

Art Unit: 3629

communication formats in which to transmit communications to the party. However, NetGram teaches address book address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction [NetGram page 4].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry and Akimoto and use address book of NetGram to store preferred communication format indicator for each recipient parties to allow the senders to reuse previously stored addresses in the electronic address book. Also, For example, email services like AOL which teaches address book for their subscribers.

**Regarding claims 5, 16 and 22,** IBM in view of Henry, Akimoto and NetGram teaches adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

**Regarding claims 6, 17 and 24,** IBM in view of Henry and Akimoto does not explicitly teach charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer. However, NetGram teaches to charge fee to sender [NetGram 9].

Art Unit: 3629

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry and Akimoto as taught by NetGram and start charging fee to recover operational costs.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

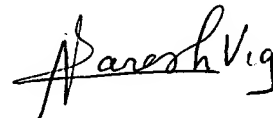
Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig  
Examiner  
Art Unit 3629

November 23, 2007